

Notice of Non-Responsive Reply

Election/Restrictions/Status

Applicant's election without traverse of Group I, claim(s) 23-34 and 38-45, drawn to a method for treating cancer, comprising administering at least one oligonucleotide, and to an antisense oligonucleotide and pharmaceutical composition thereof, in the reply filed on 11/24/2008 is acknowledged. Also acknowledged is Applicant's further election without traverse of "carcinoma," and with traverse of "TGF-beta 2" and "SEQ ID NO:30."

With regard to the election of "carcinoma," the reply is not responsive to the Requirement to elect a single type of cancer for each of claims 28-30, 39, 42, and 44. The term "carcinoma" does not specify a single carcinoma among the many different carcinomas listed therein. Applicant is required to elect a single type of carcinoma for prosecution on the merits with the elected group. A telephone call was made to Amy Dobbelaere on 1/5/2009 to request an oral election of a single carcinoma, but did not result in an election being made. Applicant is further requested to supply a listing of claims readable on the complete election including all further elections. See page 6 of the Requirement.

With regard to Applicant's traverse of the restriction to a single gene target and antisense sequence, the instant claims recite alternative gene targets, having different nucleotide sequences, and therefore necessarily different properties. The different targets and antisense do not share a significant structural feature common to their utility, and there is no evidence of record to show each antisense could be substituted one for the other, with the expectation that the same intended result would be achieved. Logically, each gene defines a different set of antisense

oligonucleotides, required to differentially and sequence specifically inhibit each gene.

Therefore, the different methods thereof do not share the same special technical feature. If it is Applicant's position the elected sequence, SEQ ID NO:30, is complementary to and capable of inhibiting more than one of the TGF-beta genes listed in the claims (see the "and/or" clause in claim 25, for example), Applicant may cite support for this assertion and the two gene targets will be examined together with the elected antisense sequence. This was noted in the previous Requirement at page 5. Applicant is reminded Linking Claim practice is in effect such that Applicant may be entitled to rejoinder of additional antisense oligonucleotides and target genes should a linking claim be found allowable. See page 5 of the Requirement.

The requirement is still deemed proper and is therefore made FINAL.

Claims 23-45, filed 8/28/06, are pending.

Claims 34-38 and 45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/24/2008.

Claims 23-33 and 39-44 remain subject to the Restriction Requirement mailed 9/23/2008 for the reasons stated therein, because the reply filed 11/24/2008 is not fully responsive to that Requirement since it did not specify a single carcinoma from the many different carcinomas recited in the claims.

Conclusion

Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis Wollenberger whose telephone number is (571)272-8144. The examiner can normally be reached on M-F, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James (Doug) Schultz can be reached on (571)272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Louis Wollenberger/
Examiner, Art Unit 1635
January 8, 2009